

REMARKS

Applicant files concurrently herewith a Request for Continued Examination (RCE) in response to the final Office Action mailed April 1, 2008 (hereinafter, "Office Action"). In the Office Action, the Examiner rejected claims 2, 8, 9, 11, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,111,164 to Kinoshita ("Kinoshita") in view of U.S. Patent No. 6,275,824 to O'Flaherty et al. ("O'Flaherty"), U.S. Patent No. 5,930,391 to Kinjo et al. ("Kinjo"), and U.S. Patent No. 7,181,438 to Szabo ("Szabo").¹

By this response, Applicant hereby amends claims 2, 8, 9, 11, 16, and 17. Claims 1, 3-7, 10, and 12-15 were previously canceled. No new matter has been added. Accordingly, claims 2, 8, 9, 11, 16, and 17 remain pending.

In light of the foregoing amendments and based on the reasoning presented below, Applicant respectfully traverses the rejection of the pending claims under 35 U.S.C. § 103(a), and requests allowance of claims 2, 8, 9, 11, 16, and 17.

I. Rejection under 35 U.S.C. § 103(a)

Applicant requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) as being unpatentable over Kinoshita in view of O'Flaherty, Kinjo, and Szabo. The Examiner's arguments do not provide an appropriate rationale to support a conclusion of obviousness regarding at least independent claims 2 and 11 in

¹ While the Examiner identifies the application of the cited art as Kinoshita in view of O'Flaherty, Kinjo, and Szabo at page 2 of the Office Action, the Examiner has applied the references in the order of Kinoshita, Kinjo, O'Flaherty, and Szabo. See Office Action, pp. 4-7. Accordingly, in this response, Applicant addresses the cited references in the order of their substantive application to the claim recitations.

light of the decision by the Supreme Court in *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007) that would enable “prompt resolution of issues pertinent to patentability.” See M.P.E.P. § 2141, 8th Ed., Rev. 6 (Sept. 2007), pp. 2100-115 and 2100-117.

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*” M.P.E.P. § 2141(II) (internal citations omitted). “Obviousness is a question of law based on underlying factual inquiries.” Id. These factual inquiries include (a) determining the scope and content of the prior art, (b) ascertaining the differences between the claimed invention and the prior art, and (c) resolving the level of ordinary skill in the art. See id. “When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.” Id.

In this application, the Examiner failed to properly apply the Graham factual inquiries, which is required to support a legal conclusion of obviousness under 35 U.S.C. § 103(a), by the incorrect characterization of the cited references, the failure to properly determine the scope and content of the cited prior art, and the failure to ascertain the differences between the claims and the cited prior art. The Examiner’s incorrect characterization and application of these references undermines the Examiner’s allegations and clearly demonstrates nonobviousness of the claimed invention. Specifically, none of the cited art, nor any obvious variant thereof, teaches or suggests, *inter alia*,

“an authentication unit configured to execute personal authentication by using the authentication information to obtain, if the authentication information is authentic, a first pass ID and a second pass ID, wherein a value of the first pass ID is equal to a value of the second pass ID;

a transfer unit configured to transfer one of the first pass ID or the second pass ID as a transferred pass ID to a first terminal which corresponds to the first user, and store the one of the first pass ID or the second pass ID that is not transferred as a stored pass ID;

a second receiving unit configured to receive the transferred pass ID and an information item including an image of a person;

a first generation unit configured to generate a temporary ID for identifying the information item when the transferred pass ID is equal to the stored pass ID;

an extracting unit configured to extract a contour of a person's face from the information item to detect an image of the person's face as a personal information item;

a second generating unit configured to generate an anonymous information item, which is the information item without the image of the person's face, by separating the detected personal information item from the information item;
[and]

a first storing unit configured to store a pair including the temporary ID and a personal ID corresponding to the personal information item,”

as recited in amended independent claim 2, and similarly recited in amended independent claim 11. By virtue of their dependence from amended independent claims 2 and 11, claims 8-9 and 16-17 respectively require at least these limitations.

Here, the legal underpinnings of a rejection under 35 U.S.C. § 103(a) are violated at least because the Examiner ubiquitously and incorrectly applies Kinoshita's identification information to all of Applicant's claim recitations. For example, the

Examiner applies Kinoshita's identification information to each of Applicant's recitations of, for example, authentication information, a first pass ID, a second pass ID, a temporary ID, and a personal ID. By attempting to apply Kinoshita's identification information, including a single ID, to each of Applicant's several, distinct claim recitations, the Examiner has necessarily failed to determine the proper scope and content of Kinoshita, to ascertain the differences between the claims and Kinoshita, and to properly apply Kinoshita.

For example, the Examiner attempts to correlate Kinoshita's identification information with Applicant's claimed *authentication information* by alleging that Kinoshita's disclosure of "the terminal apparatus accept[ing] identification information" is equivalent to Applicant's recitation of "a first receiving unit configured to receive an authentication request including authentication information of one of the users." Office Action, p. 3 (emphasis omitted). However, the Examiner then suggests that the individual components of Kinoshita's identification information, *i.e.*, "the ID, the password and the biometrics information" (id.), also correspond to Applicant's claimed first pass ID and second pass ID. Specifically, the Examiner alleges that Kinoshita teaches "an authentication unit (*i.e.*, the server computer) configured to execute personal authentication by using the authentication information, and obtain . . . two pass IDs (*i.e.*, the ID, the password and the biometrics information) whose values are the same" Id. (emphasis omitted).

However, these statements are inconsistent with one another and contrary to the plain teachings of Kinoshita. Referring, for example, to FIG. 9, Kinoshita discloses a block diagram illustrating the hardware configuration of terminal apparatuses 2, which

the Examiner alleges corresponds to Applicant's claimed first receiving unit. According to Kinoshita, "[w]hen the [identification] information is entered on an input portion 23 [of terminal apparatuses 2] . . . , the MPU 21 [of terminal apparatuses 2] accepts the identification information," and "[t]he terminal apparatuses 2 transmit the accepted identification information to the server computer 1." Kinoshita, 8:41-46. Thus, Kinoshita clearly discloses that the ID, password, and fingerprint, which the Examiner alleges correspond to Applicant's authentication information, are **received by** terminal apparatuses 2 and **sent to** server computer 1. Therefore, using the Examiner's logic, Kinoshita can not disclose or suggest that server computer 1 is "configured to execute personal authentication by using the authentication information to obtain, if the authentication information is authentic, a first pass ID and a second pass ID . . . ," as recited in amended independent claim 2.

The Examiner continues this misapplication of Kinoshita throughout the Office Action. For example, the Examiner alleges that "a transfer unit . . . configured to transfer one of the two pass IDs to one of the terminals . . ." is equivalent to "the information [in Kinoshita that] is **transmitted to the terminal apparatus [2].**" Office Action, p. 3 (emphasis added). First, this statement clearly contradicts the Examiner's previous statements. The Examiner has already alleged that the "terminal apparatus accepts identification information," and that the two pass IDs are equivalent to the ID, the password, and biometrics information (*i.e.*, Kinoshita's identification information). Id. Thus, it is unclear how the Examiner can subsequently conclude that this same information, which the Examiner previously said is input to terminal apparatuses 2 by a user, is now being transmitted to terminal apparatuses 2 by server 1.

Second, this statement also clearly contradicts the disclosure of Kinoshita. Kinoshita discloses that the information transmitted to the user is incident information that is to be provided **to the user**, and not identification information provided **by the user**. See e.g., 2:49-3:13.

Furthermore, although the Examiner suggests that Kinoshita's "Authentication Data File ID and the biometric authentication using the ID and the password" corresponds to Applicant's claimed "first generation unit [that is] configured to generate a temporary ID," this too is irreconcilable with the Examiner's previous assertions. Office Action, p. 3 (emphasis omitted). Specifically, Kinoshita does not disclose an "Authentication Data File ID," as suggested by the Examiner. Instead, the Examiner is apparently referring to the "authentication data file 15e [of Figure 8] [which includes] the identifier (ID) . . . unique to each of the managers to be provided with information." Kinoshita, 8:7-9. In other words, the ID contained in the authentication data file of Kinoshita is the same ID that the Examiner also variously alleges is equivalent to Applicant's claimed first pass ID, second pass ID, and authentication information.

Moreover, the authentication data file of Kinoshita, which includes this identifier, also includes a password and fingerprint data or voice data. In contrast, the temporary ID of the present application is used, for example, to identify an information item sent with a transferred pass ID when the item is stored. In Applicant's claims, a temporary ID, and corresponding level, is attached to an anonymous information item which is obtained by removing personal information (e.g., an image of a person's face) from the information item, and the anonymous information item is stored. The anonymous information is identified by a temporary ID, and the personal information is identified by

a personal ID. Thus, the anonymous information item and the personal information item are stored separately from each other.

Kinjo fails to overcome the deficiencies of Kinoshita, as set forth above, including the failure of Kinoshita to disclose or suggest at least the above quoted elements of amended independent claim 2, and the Examiner does not apply Kinjo against these recitations.

The Examiner appears to incorrectly rely on “Kinjo [to disclose an] **image of a person**, as the person’s face image” (emphasis in original) and “to extract a contour of the person’s face . . . , to detect the image of the person’s face.” Office Action, p. 6. If Kinjo were to include such a teaching, which it does not, Kinjo would nevertheless still fail to remedy the aforementioned deficiencies of Kinoshita. Instead, Kinjo teaches a “photographic printing apparatus” for “edge tracing processing for extracting a human contour” in which “contours of face candidate regions which are assumed to correspond to person’s faces are judged from among the plurality of contour lines which were extracted by the . . . edge tracing processing for extracting a human contour.” Kinjo, 11:66, 16:61-62, and 16:65-17:2.

O’Flaherty fails to overcome the deficiencies of Kinoshita and Kinjo, as set forth above, including the failure of Kinoshita and Kinjo to disclose or suggest at least the above quoted elements of amended independent claim 2, and the Examiner does not apply O’Flaherty against these recitations.

The Examiner appears to rely on “O’Flaherty [to disclose] a second generating unit . . . , a synthesizing unit . . . , and a second transmitting unit” Office Action, p. 7 (emphasis omitted). If O’Flaherty were to include such teachings, which Applicant

does not concede, O'Flaherty would nevertheless still fail to remedy the aforementioned deficiencies of Kinoshita and Kinjo. Instead, O'Flaherty discloses an apparatus "having a database management system 104 storing one or more extended databases 106." O'Flaherty, 4:4-5. According to O'Flaherty, "[v]irtually all access to the data stored in the extended database 106 is provided solely through [a] dataview." Id. at 4:37-38 (emphasis added). O'Flaherty states that the dataview is formed when the "database management system . . . define[s] a virtual table and save[s] that definition in the database as metadata with a user-defined name." Id. at 4:8-11 (emphasis added).

Szabo fails to overcome the deficiencies of Kinoshita, Kinjo, and O'Flaherty, as set forth above, including the failure of Kinoshita, Kinjo, and O'Flaherty to disclose or suggest at least the above quoted elements of amended independent claim 2, and the Examiner does not apply Szabo to these recitations.

The Examiner relies on Szabo to disclose "including (a) a first access level which is assigned to a first group of users of the users who can access only the anonymous information item out of the anonymous information item and the personal information item and (b) a second access level which is assigned to a second group of users of the users who can access both of the anonymous information item and the personal information item." Office Action, p. 8 (emphasis added). Even if the Examiner's characterization of Szabo was correct, which Applicant does not concede, Szabo still fails to disclose or suggest the recitations discussed above.

Instead, Szabo discloses methods for "structuring hierarchal organizational sets of information, providing an interactive search definition and ranking process, improved formatting of presented information, as well as use of applets to define and extend

functionality of computer systems.” Szabo, 28:5-9. “According to [Szabo], a set of information may be transmitted from the server to the client, for presentation to the user.” Id. at 29:43-45. “The information may be classified according to the ultimate taxonomy, regardless of the level of analysis employed by the user, or may be classified only to a lesser level of granularity, for example a level specified by the user or adaptively determined based on the user query, user profile, and the information content retrieved.” Id. at 29:45-50.

Accordingly, neither Kinoshita, nor Kinjo, nor O’Flaherty, nor Szabo, taken individually or together, teaches or suggests the recitations of amended independent claim 2. Therefore, the rejection of claim 2 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 8 and 9 should also be allowable due to their dependence from independent claim 2.

Independent claim 11, although of different scope, recites subject matter similar to that of claim 2. For reasons at least similar to the reasons set forth above in connection with amended independent claim 2, the cited references cannot support a rejection of claim 11 under 35 U.S.C. § 103(a). Therefore, the rejection of claim 11 under 35 U.S.C. § 103(a) should be withdrawn, and the claim allowed. Claims 16 and 17 should also be allowable due to their dependence from independent claim 11.

II. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

In addition, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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